

REMARKS

This communication is in response to the nonfinal Office Action issued April 9, 2003. The Examiner rejected claims 11 and 26 under 35 U.S.C. § 102 in view of U.S. Patent No. 6,295,293 to Tönnby *et al.* (Tönnby). The Examiner rejected claims 1-4, 6-10, 12-21, 23-25, and 27-31 under 35 U.S.C. § 103 in view of Tönnby in varying combinations with U.S. Patent Nos. 6,307,853 to Storch *et al.* (Storch) and 5,726,984 to Kubler *et al.* (Kubler).

Declaration Under 37 C.F.R. § 1.131

The Applicant includes with this Response a Declaration Under 37 C.F.R. § 1.131 (the Declaration), in which it is established that the claimed subject matter was invented prior to the earliest effective date of the Tönnby reference (June 4, 1997). Date redacted photocopies of original records are included with the Declaration.

The Applicant submits that the Declaration establishes invention of the claimed subject matter before the effective date of the Tönnby reference. The Applicant submits that if there are any differences between the claimed subject matter and the showing under the Declaration, such differences would have been obvious to one of ordinary skill in the art, in view of the evidence presented in the Declaration, prior to the effective filing date of the Tönnby reference. The Applicant respectfully requests favorable consideration of the Declaration.

In view of the Declaration, all rejections relying on Tönnby in whole or part are believed to be overcome, and the Applicant respectfully requests withdrawal of all such rejections. Since every rejection in the Office Action relies upon Tönnby, all of the rejections are believed to be overcome, and the application is in condition for allowance.

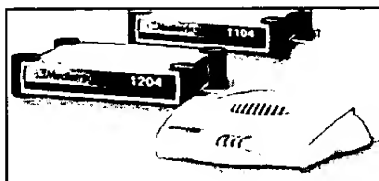
Claim Rejections Under 35 U.S.C. § 102

In sections 1-2 of the Office Action, the Examiner rejected claims 11 and 26 under 35 U.S.C. § 102 in view of Tönnby.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of claims 11 and 26 do not satisfy this burden.

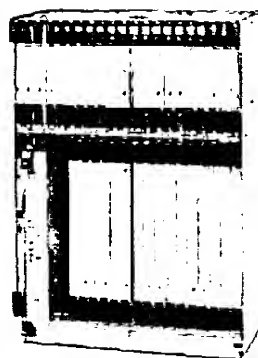
Tönnby appears to disclose an "IP access node." The IP access node includes an IP access server, a telephony server, and an IP router. See column 5 lines 10-12. The IP network terminal is separate from the IP access node. See figure 4.

In contrast and as discussed during the November 26, 2002 interview, the present application discloses and claims a telephone to packet adapter for use with a user's home telephone line or a method of using such an adapter. This adapter is quite different than the IP access node of Tönnby. For example, in a preferred embodiment, the present invention measures approximately 20cm by 20cm by 10cm and is therefore suitable for use in a user's home:

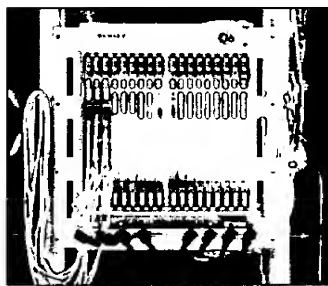


The Tönnby device, in contrast, requires various network elements that take up several rack-mounts of space:

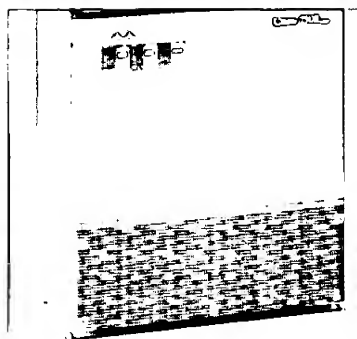
IP Access Server:



Telephony Server:



IP Router:



An IP access server with several individual ADSL modems usually takes one third of a 7 ft tall by 19 in wide telecommunications bay. A telephony server with a V5.2 interface usually takes one third of a 7 ft tall by 19 in wide telecommunications bay. An IP router usually takes one third of a 7 ft tall by 19 in wide telecommunications bay. Therefore, the Tönnby device is not suitable for use in a user's home, and the reference does not satisfy all of the requirements of the claims.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 102 to claims 11 and 26 are believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103

In sections 3-5 of the Office Action, the Examiner rejected claims 1-4, 6-10, 12-21, 23-25, and 27-31 under 35 U.S.C. § 103 in view of Tönnby modified by varying combinations of Storch and Kubler. Specifically, the Examiner rejected claims 1, 13, 19, 21, 27, and 28 in view of Tönnby modified by Storch, and claims 6-10, 14-18, 23-25, and 29-31 in view of Tönnby modified by Storch and Kubler.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of claims 1-4, 6-10, 12-21, 23-25, and 27-31 do not satisfy these burdens.

As discussed above, Tönnby does not disclose or suggest all of the recitations of the present claims. Neither Storch nor Kubler satisfy the shortcomings of Tönnby. Any

modification to the cited references to cover the present claims would require impermissible hindsight reasoning or reliance upon the Applicant's disclosure.

Furthermore, several of the rejections are improper for other reasons. Regarding claim 3, the packet network interface is a LAN interface connected to a packet network via a packet network gateway. This configuration is specifically defined in claim 3 since a local area network interface is not recognized by one of ordinary skill in the art as being a superset of a packet network interface.

Regarding claims 4 and 12, item 32 as depicted in Tönnby is not a controller circuit. It is described by Tönnby as an IP Access Server, which is further described in column 5 lines 10-14 as "[t]he IP access node comprises an IP access server 32.... The IP access server comprises a set of individual xDSL modems." The device thus cannot be considered to be a controller circuit. Furthermore, this device as described by Tönnby does not have software for control of call routing.

Regarding claims 6-10, 14-18, 23-25, and 29-31, the rejections appear to be impermissible hindsight reasoning and reliance upon the Applicant's disclosure as the motivation to modify the primary reference.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

Additional Fees

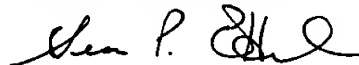
The Commissioner is hereby authorized to charge any insufficiency, including a two-month extension for response fee of \$410, or credit any overpayment associated with this

application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 20014.0002).

Conclusion

Claims 1-4, 6-21, and 23-31 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



Sean P. O'Hanlon
Reg. No. 47,252

Dated: September 8, 2003

Swidler Berlin Shereff Friedman, LLP
3000 K Street, NW
Suite 300
Washington, DC 20007
(202) 295-8429